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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,284	08/29/2005	Walter Keller	0740-70	6605
616	7590	07/11/2007		
THE MAXHAM FIRM 9330 SCRANTON ROAD, SUITE 350 SAN DIEGO, CA 92121			EXAMINER NOORISTANY, SULAIMAN	
			ART UNIT 2109	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,284	Applicant(s) KELLER, WALTER	
	Examiner Sulaiman Nooristany	Art Unit 2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/8/05, 11/18/05</u> | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

This Office Action is response to the application (10/528284) filed on 29 August 2005.

Priority

Receipt is acknowledged of a certified copy of the DE 10243243.0 application referred to in the oath or declaration or in an application data sheet. If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and within the time limit set forth in the PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

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Specifically, it does not appear that the applicant properly claimed priority since the Oath/Declaration shows that the foreign application was not submitted, however the foreign application was submitted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-28 are rejected under 35 USC 102 (b) as being anticipated by **Fleming**. US Patent No. **6,249,805**.

Regarding claim 9, Fleming teaches wherein a method to automatically handle undesired electronic mail (e-mail) in communication networks at the receiver (A computer system and method for filtering unauthorized electronic mail messages that are sent by senders to a user (Abstract, lines 1-2)), the method comprising: automatically comparing the sender address accompanying an incoming e-mail to an electronically accessed list of authorized sender addresses assigned to the receiver (The system includes a list of the identifications of the senders who are authorized to send an electronic mail message to the user (abstract, lines 3-5)); then storing the e-mail in a mailbox MB of the recipient (When the sender of the electronic mail message is determined to be authorized, the system stores the electronic mail

message in an Inbox folder (Abstract, lines 9-11)), wherein the only e-mails transferred to the receiver's mailbox are those that had clearly been sent by authorized senders;

and

performing an analysis to see if there is serial, incremental user identification occurring so that conclusions can be drawn concerning automatic attempts at breaking into the e-mail system.

(In this way, the electronic mail messages are automatically stored in the appropriate folder based on whether the sender is authorized so that the user can view the Inbox folder containing the electronic mail messages sent by authorized senders separately from the Junk Mail folder containing the electronic mail messages sent by unauthorized senders. When the sender of the electronic mail message is determined to be not authorized, the system stores the electronic mail message in a Junk Mail folder (Abstract, lines 11-20))

Regarding claim 10, Fleming further teaches the method according to claim 9, wherein there are two logically or physically, or both, separate mailboxes, said mailbox MB (Inbox folder) and a junk mailbox JMB (Junk Mail folder),

wherein the e-mail server sends to the JMB mailbox all incoming e-mails that indeed have the subscriber's correct recipient address but are not contained in the sender list on the receiving side, thus making them available for further processing selectively by the internet service provider, the administrative authorities, and by the recipient (If the retrieve identification does not match, then the authorization component stores the

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intercepted electronic mail message in a pre-designated location, such as a "Junk Mail" folder. Otherwise, the authorization component forwards the intercepted electronic mail message to the electronic mail system for normal processing and storage. With the use of such an authorization component a user can effectively filter out unauthorized (i.e., junk) electronic mail messages. Periodically, the user can view the Junk Mail folder to delete or read the electronic mail messages that were designated as junk (Col. 4, lines 24-36).

Regarding claim 11, Fleming further teaches the method according to claim 9, wherein the incoming e-mails are selectively put through an automatic handling and analysis process, which can be selectively configured by the recipient and by the ISP, selectively in the e-mail server, in a comparison device (To create an electronic mail message, the sender designates the recipient to whom the electronic mail is to be sent and creates the body (e.g., text) of the electronic mail message. The electronic mail system then forwards the electronic mail message to the recipient via a communications mechanism such as a local area network or the Internet (Col. 1, lines 14-21)), and in at least one of the mailboxes (Inbox folder or Junk mail folder), said process initiated and configured either on a case-by-case basis or permanently (The electronic mail system also allows the user to move the electronic mail messages from the Inbox folder to other folders or to delete the electronic mail messages (Col. 1, lines 59-62)).

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Claim 12 has the similar limitation of claim 11; therefore, it's rejected under the same rationale as in claims 11.

Regarding claim 13, Fleming further teaches the method according to claim 9, wherein all executable programs sent as attachments to e-mails are automatically separated in the JMB (For example, a user can indicate that all electronic mail messages received from a certain sender can automatically be stored in a designated folder, be deleted, or be forwarded to another recipient (Col. 3, lines 26-29)).

Claim 14 has the similar limitation of claim 13; therefore, it's rejected under the same rationale as in claims 13.

Claim 15 has the similar limitation of claim 13; therefore, it's rejected under the same rationale as in claims 13.

Claim 16 has the similar limitation of claim 13; therefore, it's rejected under the same rationale as in claims 13.

Regarding claim 17, Fleming further teaches the method according to claim 9, wherein if an undesired e-mail is received, discontinuation requests, or cease and desist demands, can be generated automatically and delivered to the sender (Whenever a recipient does not want to be included on a mailing list, the recipient can notify the de-spamming computer system, which will add the recipient's electronic mail address to the list of electronic mail addresses that are not to receive junk mail (Col. 3, lines 17-21)).

Claim 18 has the similar limitation of claim 17; therefore, it's rejected under the same rationale as in claims 17.

Claim 19 has the similar limitation of claim 17; therefore, it's rejected under the same rationale as in claims 17.

Claim 20 has the similar limitation of claim 17; therefore, it's rejected under the same rationale as in claims 17.

Regarding claim 25, Fleming further teaches the method according to claim 10, wherein the contents of the JMB can be cyclically deleted at specific time intervals (Certain electronic mail systems also allow a user to designate how to automatically handle a received electronic mail message. For example, a user can indicate that all electronic mail messages received from a certain sender can automatically be stored in a designated folder, be deleted, or be forwarded to another recipient (Col. 3, lines 24-29)).

Claim 26 has the similar limitation of claim 25; therefore, it's rejected under the same rationale as in claims 25.

Claim 27 has the similar limitation of claim 25; therefore, it's rejected under the same rationale as in claims 25.

Claim 28 has the similar limitation of claim 25; therefore, it's rejected under the same rationale as in claims 25.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Fleming**, US Patent No. **6,249,805**, in view of **Nolan et al.** U.S. Patent Application No. **US 2002/0091776**.

Regarding claims 21-24, Fleming teaches the method according to claim 9 [See rejection above] except for the claimed "wherein virus checks of the e-mail can be carried out selectively at an established time of day or each time a message arrives." Nolan teaches that it is well known to have "wherein virus checks of the e-mail can be carried out selectively at an established time of day or each time a message arrives" (While it is accepted that email engine processors are well known, such as, those used in centralized email virus scanning, for example, an email virus scanning program sold under the trade mark MIMESWEEPER, the systems such as MIMESWEEPER work on the gateway intercepting messages and checking them before they reach the email server [0008]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fleming's invention by utilizing virus system in which it solves the major problems of ensuring that the emails are handled in an efficient and timely manner in the email engine (as taught by Nolan).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


U.S. Patent 7,007,067 to Azvine et al..

U.S. Patent 6,460,050 to Pace et al.

U.S. Patent 6,199,102 to Cobb, Christopher Alan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sulaiman Nooristany whose telephone number is (571) 270-1929. The examiner can normally be reached on M-F from 9 to 5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu, can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sulaiman Nooristany 7/6/2007


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TC 2100